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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,522	12/19/2003	John T. Stites	005127.00273	1521
22908	7590	09/09/2004	EXAMINER	
BANNER & WITCOFF, LTD. TEN SOUTH WACKER DRIVE SUITE 3000 CHICAGO, IL 60606			BLAU, STEPHEN LUTHER	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/707,522	Applicant(s) STITES ET AL.	
	Examiner Stephen L. Blau	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 5-7,9,10,16,17,19,20,28,29,31,32,42,43,45 and 46 is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,8,11-14,18,21-27,30,33-40,44 and 47-59 is/are rejected.
- 7) ☒ Claim(s) 15 and 41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/8/04, 7/29/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 5-7, 9-10, 16-17, 19-20, 28-29, 31-32, 42-43, and 45-46 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9 July 2004.

Specification

2. The disclosure is objected to because of the following informalities:

a. In paragraph [27] it states that the top surface of the wall (40) is reference number 45 yet reference number 45 is the top surface of the bridge member (34) in figure 4.

Appropriate correction is required.

Information Disclosure Statement

3. The information disclosure statement filed 8 January 2004 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because on page 4 of 4 the non-patent literature documents due not contain a date. As such it is uncertain whether

these documents are prior art or not. It has been placed in the application file, but the information for the two non-patent literature documents referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Double Patenting

4. Claims 1-3, 8, 12-14, 18, 22-26, 30, 34-40, 44 and 48-55 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-3, 8, 12-14, 18, 22-26, 30, 34-40, 44 and 48-55 of copending Application No. 10/666,346. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 11, 22-26, 33-34, 49-50, and 54 are rejected under 35 U.S.C. 102(e) as being anticipated by Dabbs.

Dabbs discloses a rear face opposite a striking face, the rear face defining a first cavity, a single bridge member extending across a first cavity, a wall extending from a sole portion to a bridge member, the wall forming a second rear cavity, the second rear cavity and bridge member varying a center of gravity of a head with respect to a striking face, a space between a wall and a rear face, a second rear cavity being located between a bridge member and a sole portion, (Enclosure (1)), long irons 2-5 ([0002] and [0013]), a wall connecting a bridge member comprises a curve in the form of the top of the wall of the second cavity curving (Figs. 2-3), a bridge member connecting the heel and the toe (Fig. 4B), and a wall integrally formed with a sole portion (Fig. 3).

7. Claims 12-14, 18, 21, 47 and 51-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Iwata.

Iwata discloses a rear face opposite a striking face, the rear face defining a first cavity, a single bridge member extending across a first cavity, a wall extending from a top portion to a bridge member, the wall forming a second rear cavity, the second rear cavity and bridge member varying a center of gravity of a head with respect to a striking

face, a space between a wall and a rear face, a second rear cavity being located between a bridge member and a sole portion, a bridge member connecting the heel and the toe (Enclosure (2)), a wall being plastic [0042], and a wall integrally formed with a top portion (Enclosure (2)).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dabbs in view of Campau.

Dabbs discloses an adhesive insert in a second cavity (Ref. No. 76, Fig. 7, [0047]). Campau discloses a suitable adhesive being epoxy (Col. 4, Lns. 11-15). In view of the patent of Campau it would have been obvious to modify the iron of Dabbs to have an epoxy adhesive insert in order to utilize an adhesive used in the art of fixing head components together.

10. Claims 8 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dabbs in view of Solheim.

Dabbs lacks a wall comprising a plastic. Solheim discloses a head for a cavity back iron being formed of plastics (Col. 10, Lns. 27-31). In view of the patent of Solheim it would have been obvious to modify the irons of Dabbs to be formed of a plastic in order to utilize a material known in the art for forming club heads. As such the wall would be formed of a plastic.

11. Claims 35-40, 44, 48 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwata in view of Schmidt (5,472,203).

Iwata lacks a 6-9 iron and a pitching wedge. Schmidt discloses a 6-9 iron and a pitching wedge (Col. 4, Lns. 54-58). In view of the patent of Schmidt it would have been obvious to modify the iron of Iwata to include a 6-9 iron and a pitching wedge in order to utilize the advantages of Iwata for these irons.

12. Claims 56-59 are rejected under 35 U.S.C. 102(a) as being anticipated by Schmidt (5,472,203) in view of Deshumkh (6,406,382).

Schmidt discloses a first cavity (22, Fig. 2), a bridge member extending across a first cavity (81, Fig. 1), the bridge member connecting a heel and toe, a bridge member having a curved upper edge (Fig. 1), a first height dimension in an area adjacent to a heel, a second height dimension adjacent the toe, a third height dimension between a heel and toe, and a third height dimension being less than a first and second height dimension in the form of the bridge (81) being closer to the top portion at a heel and toe than at a point between a heel and toe (Fig. 1).

Schmidt lacks a bridge member having a curved lower edge, a wall extending from a sole portion to a bridge member, a wall spaced from a rear face, a wall forming a second rear cavity and a bridge member curving outward from first cavity.

Deshumkh discloses a bridge member curved outward from a first cavity (Fig. 4) having a curved upper and lower edge (Fig. 1), a wall extending from a sole portion to a bridge member, a wall spaced from a rear face, and a wall forming a second rear cavity (Fig. 7A) in order to weight an iron (Abstract). In view of the patent of Deshumkh it would have been obvious to modify the iron of Schmidt to have a bridge member having a curved lower edge, a wall extending from a sole portion to a bridge member, a wall spaced from a rear face, and a wall forming a second rear cavity in order to weight an iron head. In view of the patent of Deshumkh it would have been obvious to modify the iron of Schmidt to have a bridge member curving outward from first cavity in order to place more weight at a center of a head to maximize the energy transferred to a ball at impact.

Allowable Subject Matter

13. Claims 15 and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. None of the prior art discloses or renders as obvious a second rear cavity formed from a wall extending from a top

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portion including an epoxy and a bridge member extending across a first cavity in addition to the other elements of structure claimed.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (703) 308-1513. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 6 September 2004


STEPHEN BLAU
PRIMARY EXAMINER